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*listing of all claims readable thereon. ... The examiner does not agree that the examiner is precluded from making the present restriction requirement due to actions by a different examiner in the parent case. Each applicant (and its accompanying claims) are treated on their own merits. See particularly MPEP 811.04 which states: Even though inventions are grouped together in a requirement in a parent application, restriction or election among the inventions may be required in the divisional applications, if proper.*

*Applicant has not shown the election of species requirements set forth on pages 2-3 of the 5/7/01 Office action, to be improper or in error."*

[Unsigned, unnumbered Notice from Mr. Harvey E. Behrend, 1/16/02]

With all due respect, the final sentence by the Examiner is incorrect. First, in the communication from the Applicant, dated May 31, 2001, Applicant has shown the election of species requirements set forth on pages 2-3 of the 5/7/01 Office action, to be improper or in error for several reasons. The first occurs when it is viewed in the light of the original application and the Office's previous demands on the Applicant.

The Examiner has not responded to what Applicant said, that the original specification, claims and drawings of Serial no. 07/371,937 have already gone through a restriction by the Primary Examiner Daniel Wasil on September 16, 1991.

Serial No. 07/371937

Art Unit 224


- 2 -

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-6, 19, drawn to apparatus and method for producing a vibrational frequency of a cathode, classified in Class 376, subclass 100.

II. Claim 7, drawn to a system to monitor nuclear fusion reactions that comprises microwave radiation, classified in Class 376, subclass 245.

III. Claims 8-9, 20-22, 25-26, drawn to apparatus and method for accelerating nuclear fusion reactions, classified in Class 376, subclass 100.

  
**Daniel Wasil**  
**Primary Examiner**  
**Art Unit 224**

5. Second, the Examiner has also ignored what Applicant said regarding Examiner's re-restriction is not proper in light of 37 CFR 1.142 because the Examiner has not explained why -given Examiner Wasil's previous restriction- the latest re-restriction can support separate patents which are independent [37 CFR §1.142, (MPEP §806.04 - §806.04(j))] and [37 CFR §1.142]/or [MPEP §806.05 - §806.05(i)] distinct.

6. Third, f the Examiner has also ignored that the Applicant has warned him that he is improper because as the Court has found:

**"Respondents' claims must be considered as a whole, it being inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis." [Diamond v. Diehr, 450 U.S. 175 (1981), 450 U.S. 175, No. 79-1112, 3/3/81]**

7. Fourth, the Examiner has also ignored that the fact that the Applicant has notified him that he is attempting to coerce the Applicant into double patenting.

8. Fifth, the Examiner has also ignored the fact that the Applicant has noted that the Examiner's demand is not proper in light of MPEP §808 because given Examiner Wasil's previous restriction, Mr. Behrend has not given any substantive foundation.

9. Therefore, Applicant has stated at least five (5) reasons why the requirement should be withdrawn or modified. Applicant has pointed out errors in the Examiner's action. Not one of these issues has been responded to by the Examiner, despite the fact that there was Obligation on the Examiner to respond because Applicant satisfied his burden by citing the above issues.

10. Applicant elects II - figure 2. All claims read on the elected species.

Applicant hereby preserves the Right of Petition.

## RESPONSE AND COMPLIANCE REGARDING SECTION 5

11. The Examiner has stated:

*"On page 9 of the 6/4/01 response, applicant appears to have indicated he has not elected a species as required by section 5 on page 3 of the 5/7/01 Office action, because he does not know what the examiner means with the reference to a "monitoring configuration". The examiner is using the term in the same manner that applicant has used it in the specification at the bottom of page 15 and the top of page 16. Applicant must comply with the election of species requirement in said section 5 of the 5/7/01 Office action.*

*For applicants response to be complete, applicant must provide a listing of all claims readable on each of the elected species."*

[Unsigned, unnumbered Notice from Mr. Harvey E. Behrend, 1/16/02]

First, the Examiner's request or election of disclosed species is not proper in light of 35 USC §121 because use of different monitoring configurations may make the inventions related, and such related inventions may not be patentably distinct. Therefore the Examiner's theory of a need for restriction is not proper under 35 USC §121.

12. Second the Examiner's request or election of a monitoring configuration for purposes of examination is not proper in light of MPEP 808.02 because the Examiner has not established reasons for insisting upon his latest restriction in defiance of the record already made by Applicant and Examiner Wasil.

**"Where the related inventions as claimed are shown to be distinct...the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following: (A) separate classification thereof; (B) a separate status in the art when they are classifiable together; (C) a different field of search"**

**"Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 USC §121 is never proper. If applicant optionally restricts, double patenting may be held." [MPEP §808.02]**

13. Therefore, Applicant has stated at least two (2) reasons why the requirement should be withdrawn or modified. Applicant has pointed out errors in the Examiner's action. Not one of these issues has been responded to by the Examiner, despite the fact that there was Obligation on the Examiner to respond, because Applicant satisfied his burden by citing the above issues.

14. Applicant elects the monitoring configuration described in the specification on pages 5 through the top of page 15, with means to enable a mechanical vibration of the material, providing means to produce the vibration, and means to detect the frequency of said vibration using the displacement (page 7) of the electrode. All claims read on the elected species. Applicant hereby preserves the Right of Petition.

**NO RESPONSE TO APPLICANT'S REQUEST FOR SUGGESTIONS**

15. Applicant requested constructive assistance and suggestions from the Examiner in drafting one or more acceptable claims [pursuant to MPEP 707.07(j)] and in making constructive suggestions [pursuant to MPEP 706.03(d)] on 1/31/01. The Examiner has not complied. Applicant again respectfully requests constructive assistance and suggestions from the Examiner in drafting one or more acceptable claims [pursuant to MPEP 707.07(j)] and in making constructive suggestions [pursuant to MPEP 706.03(d)].

16. The U.S. Supreme Court has ruled that any *pro se* litigant is entitled to less stringent standards [U.S. Rep volume 404, pages 520-521 (72)]. In the present application, the Examiner appears to be attempting to coerce double patenting despite a record at the Office and said Honorable Court. Attention of the Office and Court is directed to the fact that this has continued even after Applicant cited violations by the Examiner in this matter of MPEP §808, 37 CFR 1.142, and *Diamond v. Diehr* [450 U.S. 175 (1981); 450 U.S. 175, No. 79-1112, 3/3/81] on 1/31/01.

Applicant has fully complied with each and every of the Examiner's requests of the Office's Notice dated 1/16/02.

Respectfully,



Mitchell R. Swartz, ScD, MD, EE  
Post Office Box 81135  
Wellesley Hills, Mass. 02481

**Certificate Of Mailing [37 CFR 1.8(a)]**

February 12, 2002

To Whom it Does Concern:

I hereby certify that this correspondence will be deposited with the United States Postal Service by First Class Mail, postage prepaid, in an envelope addressed to

"The Commissioner of Patents and Trademarks  
Washington, D.C. 20231" on the date below.

Thank you.

Sincerely,

February 12, 2002

M.R. Swartz





## UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,480	12/28/2000	Mitchell R. Swartz		7971

7590 01/16/2002

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EXAMINER
BEHREND, HARVEY E

ART UNIT	PAPER NUMBER
3641	

DATE MAILED: 01/16/2002

Paper No.

### Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment filed on 6/4/01 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on September 8, 2000 (see 65 Fed. Reg. 54603, Sept. 8, 2000, and 1238 O.G. 77, Sept. 19, 2000). In order for the amendment to be compliant, applicant must supply the following omissions or corrections in response to this notice.

THE FOLLOWING ITEMS ARE REQUIRED FOR COMPLIANCE WITH RULE 1.121 (APPLICANT NEED NOT RE-SUBMIT THE ENTIRE AMENDMENT):

- ☐ 1. A clean version of the replacement paragraph(s)/section(s) is required. See 37 CFR 1.121(b)(1)(ii).
- ☐ 2. A marked up version of the replacement paragraph(s) is required. See 37 CFR 1.121(b)(1)(iii).
- ☐ 3. A clean version of the amended claim(s) is required. See 37 CFR 1.121(c)(1)(i).
- ☐ 4. A marked up version of the amended claim(s) is required. See 37 CFR 1.121(c)(1)(ii).

Explanation: \_\_\_\_\_

(LIE: Please provide specific details for correction to assist the applicant. For example, "the clean version of claim 6 is missing.").

For further explanation of the amendment format required by 37 FR 1.121, see MOEP § 714 and the USPTO website at <http://www.uspto.gov/web/offices/dcom/olia/pbg/sampleaf.pdf>. A condensed version of a sample amendment format is attached.

- ☐ **PRELIMINARY AMENDMENT:** Unless applicant supplies the omission or correction to the preliminary amendment in compliance with revised 37 CFR 1.121 noted above within ONE MONTH of the mail date of this letter, examination on the merits may commence without entry of the originally proposed preliminary amendment. This notice is not an action under 35 U.S.C. 132, and this ONE MONTH time limit is not extendable.
- ☐ **AMENDMENT AFTER NON-FINAL ACTION:** Since the above mentioned reply appears to be *bona fide*, applicants is given a TIME PERIOD of ONE MONTH or THIRTY DAYS from the mailing of this notice, whichever is longer, within which to **supply the omission or correction noted above** in order to **avoid abandonment**. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Legal Instruments Examiner(LIE)

Application/Control Number: 09/750,480

Art Unit: 3641



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Page 3

Applicant has not shown the election of species requirements set forth on pages 2-3 of the 5/7/01 Office action, to be improper or in error.

It would represent a serious burden on the examiner to search and examine claims to each of the species referred to each of the groupings in sections 2-5 of the 5/7/01 Office action as evidenced for example just by the widely varying systems/structures illustrated in the different figures in the drawings.

See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Any inquiry concerning this communication should be directed to Mr. Behrend at telephone number (703) 305-1831.

Behrend/cw  
October 30, 2001

HARVEY BEHREND  
PRR